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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: Reimus, David J.

Serial No.: 09/927,165

Filed: 08/10/2001

Group Art Unit: 2635

Examiner: Wong, Albert Kang

For: REMOTE SIGNALLING TRANSMITTER FOR USE
IN VARIOUS VEHICLE SYSTEMS

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RESPONSE

MAR 11 2004

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Technology Center 2600

Dear Sir:

This paper is responsive to the Office Action mailed on December 4, 2003 (Paper No. 3).

Applicant respectfully traverses the rejections under 35 U.S.C. §103. None of the claims can be considered obvious because there is no *prima facie* case of obviousness.

It is axiomatic that there must be a proper legal motivation for modifying a reference to establish a *prima facie* case of obviousness. Where a proposed modification would defeat an intended operation of the teachings of a reference, such a modification cannot be made because there is no motivation for making it. In this instance, the Examiner proposes removing the buffer 164 from the embodiment of Figure 10 of the *Hill* reference. That modification cannot be made because the buffer performs a function intentionally provided by the *Hill* teachings. Specifically, as mentioned at the bottom of

column 13 and the top of column 14, the buffer 164 minimizes the effect of parasitic impedances. In column 2, for example, at lines 23-32, *Hill* teaches that a handheld transmitter experiences parasitic impedance because of the user's hand. The buffer 162 is included in the embodiment of Figure 10 specifically to address that problem. Also in column 2, *Hill* teaches at lines 54 and 55 that the "primary advantage of the present invention is to overcome the limitations of the known art." In other words, a primary object of the *Hill* invention is to avoid the parasitic impedance from the art discussed in the background of that patent. The buffer 162 is intended to perform exactly that function. If one were to remove the buffer, the intended operation of the teachings of the *Hill* reference would be defeated and the modification cannot be made.

The embodiment of Figure 11 is better explained in Figures 12 and 13 and neither has an antenna coupled to an emitter. Therefore, Figure 11 does not provide a basis for an obviousness rejection.

Applicant traverses the rejection based upon the proposed combination of *Hill* with *Handfield*. There is no *prima facie* of obviousness. There is no motivation for combining *Hill* and *Handfield* because the intended substitution would defeat the operation of the *Hill* reference. At column 4, lines 51-67, *Hill* specifically teaches a particular type of antenna is required for the operation of the *Hill* embodiments. *Hill* teaches that the antenna should be an inductor having a DC center point and an AC balanced oscillating point that "provides a location along antenna 11 where the AC voltage magnitude of the oscillating outputs of first and second oscillators 12 and 15 are both substantially zero." The AC and DC center points of the *Hill* antenna provide a

“balanced” oscillator arrangement. This balanced oscillator design allows for not having tight tolerances on resonating circuits as taught by *Hill* in column 4, lines 60-61.

If one were to modify *Hill* by removing the specific antenna design and substituting for that the wheel of *Handfield*, the intended antenna operation of the *Hill* reference would be lost. Therefore, the combination cannot be made and none of the claims can be considered obvious.

Additionally, as mentioned above, removing a buffer from the embodiment of Figure 10 of *Hill* defeats the intended operation of that embodiment and, therefore, cannot be used to establish a *prima facie* case of obviousness.

Applicant specifically disagrees with and challenges the Examiner’s statement in paragraph 4 of the office action where the Examiner states:

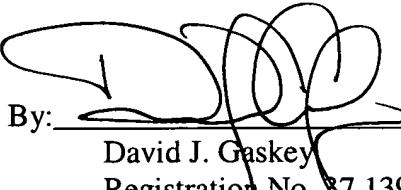
Further, as evidenced by Applicant’s lack of disclosure regarding the need for a buffer circuit and means for providing the same functionality as said circuit, it is considered an admission that methods of providing the same functionality without the buffer circuit would have been known to one of ordinary skill in the art at the time of the invention.

The Examiner cannot use Applicant’s disclosure when developing an analysis under 35 U.S.C. §103. To do so constitutes hindsight, which is not permitted. Further, if the Examiner is going to contend that Applicant’s disclosure is somehow an admission as stated by the Examiner in the Office Action, the Examiner must come forward with some evidence to support that interpretation. Applicant’s disclosure is not (and cannot be interpreted to be) an admission of the type suggested by the Examiner.

As there is no motivation for making the proposed modifications to the teachings of the *Hill* reference, none of the claims can be considered obvious. This case is in condition for allowance.

Respectfully submitted,

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Dated: March 2, 2004

CERTIFICATE OF MAILING

I hereby certify that the enclosed Response is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 on March 2, 2004.


Theresa M. Palmateer

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